UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
EL PASO DIVISION

LUCCHESE, INC.	)	
40 Walter Jones Boulevard	)	
El Paso, Texas 79906	)	
Plaintiff,	)	
	)	**CIVIL ACTION NO. 3:17-CV-135**
v.	)	
	)	
JOHN WAYNE ENTERPRISES, LLC	)	
210 62nd Street	)	
Newport Beach, California 92663	)	
Defendant.	)	

PLAINTIFF'S ORIGINAL COMPLAINT FOR INJUNCTIVE RELIEF UNDER THE DECLARATORY JUDGMENT ACT

Plaintiff Lucchese, Inc., a Delaware corporation located and doing business at 40 Walter Jones Boulevard, El Paso, Texas 79906 (hereinafter "Lucchese"), through its undersigned counsel, hereby brings this Complaint for Injunctive Relief under the provisions of the federal Declaratory Judgment Act, 28 U.S.C. § 2201 against John Wayne Enterprises, LLC, a California limited liability company, located and doing business at 210 62nd Street, Newport Beach, California 92663 (hereinafter "JWE"), and hereby alleges the following:

SUMMARY OF CASE

1. Over the past several months, JWE, both on its own and through its lawyers, has accused Lucchese of infringing the **JOHN WAYNE** trademark and violating the right of publicity of the estate of the late actor John Wayne, most recently stating "we will address John Wayne's grievances through court action" in an electronic mail message dated April 27, 2017, a copy of which is attached as Exhibit 1.

JURISDICTION & VENUE

2. This Court has original jurisdiction under Title 28 United States Code §§ 2201, 1331, and 1338(a), and Title 15 United States Code §§1116, 1119, and 1121.

3. The matter in controversy exceeds, exclusive of interest and costs, the sum of ONE MILLION DOLLARS ($1,000,000.00).

4. Venue in this Judicial District is proper pursuant to 28 U.S.C. §§ 1391 in that Plaintiff resides in this District and the acts, events or omissions that JWE accuses Lucchese of took place in this District.

FACTUAL BACKGROUND

5. Lucchese and its predecessors-in-interest have a long and rich history with the famous actor John Wayne and his estate. According to a letter John Wayne wrote to Lucchese on December 29, 1977, attached and made a part hereof as Exhibit 2, the relationship went back 50 years even then.

6. John Wayne was photographed trying on Lucchese boots at the Lucchese store in San Antonio on more than one occasion. Two photos taken in 1951 are attached and made a part hereof as Exhibit 3 and Exhibit 4.

7. An article about John Wayne and his long-standing friendship with Sam Lucchese titled "Boots Fit for a Duke" appeared in the October 1976 edition of Esquire magazine, a copy of which is made a part hereof as Exhibit 5.

8. John Wayne never objected to the fact that Lucchese was proud of his relationship with the company.

9. JWE regularly associates itself and John Wayne with Lucchese and **LUCCHESE** boots, as an article from John Wayne magazine, attached and made a part hereof as Exhibit 6;

postings from the **JOHN WAYNE** Facebook page, attached and made a part hereof as Exhibit 7; and a video attached and made a part here of as Exhibit 8 make clear.

10. JWE has been well aware of the long and close relationship between John Wayne and Lucchese and promoted that relationship.

11. Representatives of JWE and Lucchese have discussed marketing efforts and cooperation on numerous occasions over the past several years. On one occasion in 2010, Lucchese manufactured a pair of custom **JOHN WAYNE** boots for sale at an auction at The Alamo in San Antonio.

12. Beginning in 2014, Lucchese and JWE engaged in numerous discussions about a licensing or marketing agreement. Representatives of JWE visited Lucchese's facility in El Paso, where the photos attached as Exhibits 3 and 4 are prominently displayed, and inspected Lucchese's marketing material.

13. On December 19, 2016, counsel for JWE sent a demand letter to Lucchese threatening litigation over actions that JWE perceived as violations of federal and California law. The letter included the following language, "There can be no question that Lucchese's blatant unauthorized uses of John Wayne's name, image and likeness entitle JWE to significant damages pursuant to these statutory and common law causes of action." A copy of this letter is attached and made a part hereof as Exhibit 9.

14. After exchanges of several electronic mail messages and letters, counsel for JWE sent counsel for Lucchese a letter on March 9, 2017, once again threatening to take legal action: "At this point, JWE believes it has no choice but to take the next step to protect its rights with the Court." A copy is attached and made a part hereof as Exhibit 10.

15. Lucchese has consistently negotiated in good faith and attempted to restart negotiations with a goal of reaching not only a settlement of the dispute between the parties but also establishing a marketing or licensing agreement that would benefit both parties.

16. Unfortunately, Lucchese finds the demands of JWE to be unreasonable, if not unrealistic.

17. In turn, JWE has rejected Lucchese's proposals for settlement as a "Complete non-starter." See Exhibit 1.

18. Contrary to the assertions of counsel for JWE, Lucchese has never sold boots under the moniker "John Wayne Toe," nor has it ever used the **JOHN WAYNE** name as a trademark.

19. Although Lucchese used the industry term of art "John Wayne Toe" in an online glossary for a style of a toe, the #7 toe, in an online glossary from November 2, 2013 until February 15, 2017, such use does not rise to the level of endorsement, sponsorship, or trademark use, as "John Wayne Toe" is a descriptive term of art in the industry.

20. Third parties with which Lucchese has either no relationship or a relationship that simply involves the purchase of boots have used the term "John Wayne Toe" to identify #7 toes. Lucchese has never instructed or directed anyone to use this term.

21. Lucchese's use of the name **JOHN WAYNE** and his image to explain the history and heritage of the **LUCCHESE** brand were done with the knowledge, if not consent, of John Wayne during his lifetime and the knowledge, if not the consent, of JWE since then.

22. All uses of the name **JOHN WAYNE** and image have been done either to set out the history of Lucchese and/or for other informational purposes.

23. Lucchese has not made source-identifying or trademark use of the name **JOHN WAYNE** and image.

24. Even if Lucchese had made source-identifying or trademark use of the name **JOHN WAYNE** and image, JWE has acquiesced to Lucchese's use of the name **JOHN WAYNE** and his image; therefore, any claims of trademark infringement or violations of the right of publicity will fail due to the legal theories of laches, acquiescence, and estoppel.

DECLARATORY RELIEF SOUGHT UNDER 22 U.S.C. § 2201

25. Lucchese full adopts, re- lleges and incorporates all of the above paragraphs as if fully set forth herein. Lucchese is entitled to declaratory relief as requested herein.

26. WHEREFORE, PREMISES CONSIDERED, Plaintiff Lucchese, Inc. prays that this Court issue a declaration that:

a. JWE, its agents, assigns, employees, attorneys, and all other persons acting in concert or in participation with them do not possess rights sufficient to permit said parties to charge or assert, whether verbally or in writing, that Lucchese has infringed any intellectual property rights, including the right of publicity or trademark rights under federal or state law, of JWE by virtue of Lucchese's non-trademark, non-source-identifying use of the **JOHN WAYNE** name and image;

b. JWE, its agents, assigns, employees, attorneys, and all other persons acting in concert or in participation with them do not possess rights sufficient to permit said parties to charge or assert, whether verbally or in writing, that Lucchese has infringed any intellectual property rights, including the right of publicity or trademark rights under federal or state law, of JWE due to JWE's consent, implied or otherwise, to such use by Lucchese;

c. JWE, its agents, assigns, employees, attorneys, and all other persons acting in concert or in participation with them do not possess rights sufficient to permit said parties to charge or assert, whether verbally or in writing, that Lucchese has infringed any intellectual property rights, including the right of publicity or trademark rights under federal or state law, of JWE by virtue of JWE's acquiescence to such use under the legal theories of laches, estoppel, and acquiescence;

d. That this Court award to Lucchese its attorneys' fees, costs, and expenses in this action, and grant such other and further relief as this Court may deem just.

Respectfully submitted,

SESSIONS & ASSOCIATES, PLLC

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